

## **REMARKS**

In the Final Action dated July 22, 2004, claims 6-20 are pending. Claims 11-17 and 19-20 are withdrawn from further consideration as drawn to non-elected subject matter. Claims 6-10 and 18 are rejected.

This Response addresses each of the Examiner's rejections. Specifically, in an effort to favorably advance prosecution of the present application, Applicants have amended independent claim 6 by deleting the homology language and the language relating to hybridization conditions. Clauses (iv) and (v) have also been deleted from claim 6 and are now delineated in new claim 21. Claims 7-10 ultimately depend from independent claim 6. New claim 22 is supported by original claim 18 and depends upon claims 6-10 and 21. Claim 18 is therefore canceled. Claims 11-17 and 19-20, directed to non-elected subject matter, are also canceled. No new matter is introduced. Applicants therefore respectfully submit that the present application is in condition for allowance. Favorable consideration of all pending claims is therefore respectfully requested.

Claims 6-10 and 18 are rejected under 35 U.S.C. §102(e) as allegedly anticipated by Guastella (U.S. 5,789,201, 1998).

Applicants respectfully submit that the '201 patent does not teach or suggest any of SEQ ID NOS: 6, 7, 8 or 9, as presently claimed. Therefore, the '201 patent does not anticipate the subject matter as presently claimed. Withdrawal of the rejection based on the '201 patent is therefore respectfully requested.

Claims 6-10 and 18 rejected under 35 U.S.C. §112, first paragraph, as allegedly failing to comply with the written description requirement. Claims 6-10 and 18 are further

rejected under 35 U.S.C. §112, first paragraph, as allegedly lacking enabling support. The Examiner's rejections are principally directed to the aspects of the claims that encompass homologs, variants or derivatives of the specific polypeptides as set forth in SEQ ID NO: 7 and SEQ ID NO: 9.

It is respectfully submitted that the polypeptides as previously claimed are adequately supported by the specification in full compliance with 35 U.S.C. §112, first paragraph. However, in an effort to expedite allowance of the present application, Applicants have amended the claims to delete the sequence homology and hybridization language. Applicants reserve the right to pursue the subject matter embodied in the claims as originally filed in a continuation application. Accordingly, the rejections under 35 U.S.C. §112, first paragraph are overcome. Withdrawal of the rejections is respectfully requested.

In view of the foregoing amendments and remarks, it is firmly believed that the subject application is in condition for allowance, which action is earnestly solicited.



Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Xiaochun Zhu', with a stylized flourish extending from the end.

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|   |                                      |                                   |  |                               |                                 |  |
|---|--------------------------------------|-----------------------------------|--|-------------------------------|---------------------------------|--|
| <b>AMENDMENT TRANSMITTAL LETTER (Large Entity)</b>  |                                      |                                   |  |                               | Docket No.<br><b>11686A</b>     |  |
| Applicant(s): <b>Suzanne Cory, et al.</b>   |                                      |                                   |  |                               |                                 |  |
| Application No.<br><b>09/925,674</b>  | Filing Date<br><b>August 9, 2001</b> | Examiner<br><b>Sumesh Kaushal</b> | Customer No.<br><b>23389</b>   | Group Art Unit<br><b>1636</b> | Confirmation No.<br><b>3390</b> |  |
| Invention: <b>NOVEL MAMMALIAN GENE, BCL-W, BELONGS TO THE BCL-2 FAMILY OF APOPTOSIS-CONTROLLING GENES</b>   |                                      |                                   |  |                               |                                 |  |
| <b>COMMISSIONER FOR PATENTS:</b>  |                                      |                                   |  |                               |                                 |  |
| Transmitted herewith is an amendment in the above-identified application.<br>The fee has been calculated and is transmitted as shown below.   |                                      |                                   |  |                               |                                 |  |
| <b>CLAIMS AS AMENDED</b>  |                                      |                                   |  |                               |                                 |  |
|   | CLAIMS REMAINING<br>AFTER AMENDMENT  | HIGHEST #<br>PREV. PAID FOR       | NUMBER EXTRA<br>CLAIMS PRESENT   | RATE                          | ADDITIONAL<br>FEE               |  |
| TOTAL CLAIMS  | 12 -                                 | 23 =                              | 0  | x \$50.00                     | \$0.00                          |  |
| INDEP. CLAIMS   | 1 -                                  | 4 =                               | 0  | x \$200.00                    | \$0.00                          |  |
| Multiple Dependent Claims (check if applicable) <input type="checkbox"/>  |                                      |                                   |  |                               | \$0.00                          |  |
| <b>TOTAL ADDITIONAL FEE FOR THIS AMENDMENT</b>  |                                      |                                   |  |                               | <b>\$0.00</b>                   |  |
| <div style="display: flex; flex-direction: column; gap: 10px;"><div><input checked="" type="checkbox"/> No additional fee is required for amendment.</div><div><input type="checkbox"/> Please charge Deposit Account No. _____ in the amount of _____</div><div><input type="checkbox"/> A check in the amount of _____ to cover the filing fee is enclosed.</div><div><input checked="" type="checkbox"/> The Director is hereby authorized to charge payment of the following fees associated with this communication or credit any overpayment to Deposit Account <b>19-1013/SSMP</b><div style="margin-left: 20px;"><input checked="" type="checkbox"/> Any additional filing fees required under 37 C.F.R. 1.16.<br/><input checked="" type="checkbox"/> Any patent application processing fees under 37 CFR 1.17.</div></div><div><input type="checkbox"/> Payment by credit card. Form PTO-2038.</div></div> <p><b>WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.</b></p> |                                      |                                   |  |                               |                                 |  |
| <div style="text-align: center;"><br/>_____<br/><i>Signature</i></div> <p><b>Xiaochun Zhu</b><br/><b>Registration No. 56,311</b><br/><b>Scully, Scott, Murphy &amp; Presser</b><br/><b>400 Garden City Plaza-STE 300</b><br/><b>Garden City, New York 11530</b><br/><b>(516) 742-4343</b></p>  |                                      |                                   | <div style="text-align: right;">Dated: <b>March 25, 2005</b></div> <div style="border: 1px solid black; padding: 10px; margin-top: 10px;"><p>I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on</p><p style="text-align: center;"><u>March 25, 2005</u><br/>(Date)</p><div style="text-align: center;"><br/>_____<br/><i>Signature of Person Mailing Correspondence</i></div><p style="text-align: center;"><b>Xiaochun Zhu</b><br/><i>Typed or Printed Name of Person Mailing Correspondence</i></p></div> |                               |                                 |  |
| cc: XZ:ab   |                                      |                                   |  |                               |                                 |  |